

REMARKS/ARGUMENTS

Favorable reconsideration of this application in view of the above amendment and following remarks is respectfully requested.

Claims 1-4, 6, and 10-14 are pending. In the present amendment, Claims 1-4, 6, and 10-12 are currently amended, Claims 5 and 7-9 are canceled without prejudice or disclaimer, and new Claims 13-14 are added. Support for the present amendment can be found in the original specification, for example, at page 9, line 20 to page 10, line 2, at page 11, lines 3-11, at page 22, lines 10-13, and in original Claim 5. Thus, it is respectfully submitted that no new matter is added.

In the outstanding Office Action, Claims 1-12 were rejected on the ground of nonstatutory obviousness-type double patenting over Claims 1-5 of Takahiro (U.S. Patent No. 6,942,220) in view of Lew et al. (U.S. Patent No. 4,582,330, hereinafter “Lew”); Claims 1-12 were rejected under 35 U.S.C. § 112, second paragraph; and Claims 1-12 were rejected under 35 U.S.C. § 102(b) as anticipated by Nicholson (U.S. Patent No. 5,433,456).

In response to the double patenting rejection of Claims 1-12 over Claims 1-5 of Takahiro, Applicants respectfully traverse the rejection. It is noted that Claims 5 and 7-9 are canceled without prejudice or disclaimer. Thus, the rejection of these claims is moot. Further, it is respectfully submitted that Claims 1-5 of Takahiro do not disclose or suggest a metal gasket wherein “a maximum dimension of the metallic ring in a diameter direction of a longitudinal section, in a non-compression state, is larger than a maximum dimension of the metallic ring in a direction perpendicular to the diameter direction,” as recited in amended Claim 1. Instead, Takahiro merely discloses in Claims 1 and 2 that a metal ring is fitted into at least one trough portion of a metal gasket and the ring “has a U-shaped or V-shaped longitudinal cross section.” Further, Takahiro does not disclose or suggest “a metallic rectangular cross section ring,” as claimed in amended claim 6 or “a metallic elliptical cross

section ring or a metallic oval cross section ring,” as claimed in amended Claims 10-12.

Additionally, Lew does not cure the deficiencies of Takahiro. Accordingly, it is respectfully requested that the double patenting rejection of Claims 1-12 be withdrawn.

Turning now to the rejections under 35 U.S.C. § 112, second paragraph, it is noted that Claims 5 and 7-9 are hereby canceled without prejudice or disclaimer, and thus the rejections of these claims are moot. Claims 1-4, 6, and 10-12 are hereby amended to cure the issues cited in the Office Action. In view of amended Claims 1-4, 6, and 10-12, it is believed that all pending claims are definite and no further rejections on that basis are anticipated. However, if the Examiner disagrees, the Examiner is invited to telephone the undersigned who will be happy to work with the Examiner in a joint effort to derive mutually acceptable language.

Turning now to the rejection under 35 U.S.C. § 102(b), Applicants respectfully request reconsideration of this rejection and traverse this rejection, as discussed below.

Amended Claim 1 recites:

A combined ring-shaped metal gasket disposed between two sealing object members, the gasket comprising:

at least two pieces of valley portions dented in a second direction perpendicular to a first direction, and extending from a contact portion of one sealing object member to an other sealing object member, wherein

at least one metallic ring is fitted to at least one of said valley portions, and

a maximum dimension of the metallic ring in a diameter direction of a longitudinal section, in a non-compression state, is larger than a maximum dimension of the metallic ring in a direction perpendicular to the diameter direction.

Amended Claim 1 describes at least one metallic ring fitted into valley portions of a ring-shaped metal gasket. As stated in the original specification at page 23, line 7, because the metallic ring is fitted to at least one of the valley portions, even if an excessive

compressive load is applied to the ring-shaped metal gasket, the metallic ring acts as a reinforcement member, suppressing plastic deformation of the gasket and at the same time, preventing generation of metal fatigue in the gasket. It is respectfully submitted that the cited reference does not disclose or suggest every feature recited in amended Claim 1.

Nicholson describes a metal spring energized seal 22' having two convolutions 24' which partially enclose and each retain a metal spring 28.¹ The springs are helically coiled and comprised of a corrosion resistant nickel alloy.²

However, it is respectfully submitted that Nicholson does not disclose or suggest a metal gasket wherein "a maximum dimension of the metallic ring in a diameter direction of a longitudinal section, in a non-compression state, is larger than a maximum dimension of the metallic ring in a direction perpendicular to the diameter direction," as recited in amended Claim 1.

Instead, Nicholson in Figure 2A merely shows two rings 28 fitted into convolutions 24'. Figure 2A of Nicholson does not disclose or suggest any specific dimensions of the springs 28 fitted into the convolutions 24'. Further, the rings 28 in Figure 2A of Nicholson appear to be circular. Thus, the condition that "a maximum dimension of the metallic ring in a diameter direction of a longitudinal section, in a non-compression state, is larger than a maximum dimension of the metallic ring in a direction perpendicular to the diameter direction" is not shown in Figure 2A of Nicholson. Additionally, instead of discussing specific dimensions of the springs 28, Nicholson simply states that "each spring 28 is selected for the proper parameters as required by a particular application."³ Further, nothing in Nicholson suggests that the "proper dimensions" are the claimed dimensions. Accordingly, it

¹ See Nicholson, at col. 2, lines 65-68.

² See Nicholson, at col. 2, line 68 to col. 3, line 19.

³ See Nicholson, at col. 3, lines 11-12.

Application No. 10/551,438
Reply to Office Action of November 3, 2008

is respectfully requested that the rejection of Claim 1 as anticipated by Nicholson, be withdrawn.

Claims 2-4, 6, and 10-12 depend on Claim 1, and therefore are patentable for at least the reasons discussed above with respect to Claim 1. Further, Nicholson does not disclose or suggest “a metallic rectangular cross section ring,” as claimed in amended claim 6 or “a metallic elliptical cross section ring or a metallic oval cross section ring,” as claimed in amended Claims 10-12. Accordingly, it is respectfully requested that the rejection of dependent Claims 2-4, 6, and 10-12 be withdrawn.

New Claims 13 and 14 are added by the present amendment. Support for new Claims 13 and 14 can be found in the original specification, for example, at page 11, lines 3-11. Thus, it is respectfully submitted that no new matter is added. Additionally, new Claims 13 and 14 are dependent on Claim 1, and are thus believed to be patentable for at least the reasons discussed above with respect to Claim 1. Accordingly, it is respectfully submitted that new Claims 13 and 14 further patentably define over Nicholson.

Consequently, in view of the present amendment, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal allowance. A Notice of Allowance is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Gregory J. Maier
Attorney of Record
Registration No. 25,599

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 08/07)

Colin B. Harris
Registration No. 58,969